

REMARKS/ARGUMENTS

1. Amendments to the Specification

The new priority claim has been deleted.

2. Amendments to the Claims

Claims 1-13 and 25 remain in this application. Applicants respectfully requests reconsideration and withdrawal of all rejections.

3. Rejections under 35 U.S.C. § 112

Examiner has rejected claims 1–13 and 25 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More specifically, Examiner asserts that it is unclear what the intended scope of a limitation is since the claims do not set forth any structure or amount of “solids.” The Examiner goes on to state that the limitation attempts to compare the amount of filler as a percentage when viewed against an amount of solids, without providing a proper standard as to what amount of solids, if any, are present in the claimed invention.

Applicants respectfully submit that the amount of solids is clear. Applicants respectfully direct the Examiner to paragraphs [0036] and [0037] of Published Patent Application Number 2005/0116010 A1 (page 6, lines 5-16 of the Specification as Filed under PCT/FI03/00229). This portion of the specification ends with the following:

[0037] . . . Typically, the fibrous pulp contains 95% of water, and the amounts of fibre and additive are in the same proportion than in the finished fibrous product. Thus, 40 to 90% of the amount of solids is fibrous material, and 10 to 60% are additives and auxiliary substances (containing fillers).

Pursuant to MPEP § 2173.01, Applicants may use any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. The above referenced portion of the specification clearly states that the structure includes fibrous material, additives and

auxiliary substances containing fillers. This portion of the specification clearly states the amount of solids. This portion of the specification details the amount of solids, the relationship between granulated filler and the other fillers, and the relationship of the amount of solids to the rest of the fibrous pulp. Applicants respectfully submit that the § 112, second paragraph rejection based on the structure or amount of solids is no longer appropriate and should be withdrawn.

The Examiner rejected claim 8 under 35 U.S.C. § 112, second paragraph, as being indefinite due to the recitation of “fine” and “flexible.” Applicants respectfully submit that the specification need not disclose how to measure a degree of fineness or a degree of flexibility associated with the recitation. Pursuant to MPEP § 2164.01, a patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). Applicants respectfully submit that the method of measuring fine and flexible associated with the recitation are well known in the art. Applicants respectfully submit that the § 112, second paragraph rejection is no longer appropriate and should be withdrawn. Applicants respectfully submit that the claim is definite.

4. Rejections under 35 U.S.C. § 102/103

The Examiner rejected claims 1-13 and 25 under 35 U.S.C. § 102(b) as being anticipated, or alternatively under 35 U.S.C. § 103(a) as obvious over WO 01/79606 to Gronroos (“Gronroos”). The Examiner rejected claims 12 and 13 under 35 U.S.C. § 103(a) as obvious over Gronroos in view of U.S. Published Patent Application No. 2003/0106658 to Ilmonen.

Rejection under 35 U.S.C. § 103

The Examiner states that “[a]bsent evidence to the contrary, the amount of filler in Grönroos appears to be 3 to 60% and 30% to 60% of any amount of solids present or not present in the claimed invention.” Emphasis added. However the Examiner previously stated that “Grönroos does not appear to specifically teach that the amount of filler used is 3 to 60% of an amount of solids and 30% to 60% of the amount of solids.” Emphasis added. The Examiner fails to cite a single reference in Grönroos to support the recitations of claims 1 and 25.

The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." MPEP § 2142. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Applicants respectfully submit that Examiner's own statement that Grönroos does not appear to specifically teach a claim recitation of independent claim 1 and dependent claim 25 means that under Grönroos cannot anticipate claims 1-13 and 25. Applicants respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102 rejection.

Applicants respectfully submit that claim 1 and claim 25, directly dependent from independent claim 1, are patentably distinct over Gronroos based at least on the previously cited recitations in independent claim 1 and claim 25. Accordingly, applicants submit that independent claim 1 is in condition for allowance. Such action is respectfully requested.

Rejection under 35 U.S.C. § 103

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicants are under no obligation to submit evidence of nonobviousness. The Examiner's rejections fail to meet this criteria. Applicants respectfully submit that Examiner has failed to establish a *prima facie* case of obviousness.

Applicants respectfully submit that Examiner's statement "[a]bsent evidence to the contrary . . ." is analogous to taking Official Notice. Applicants respectfully remind the Examiner that Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. MPEP § 2144.03. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. MPEP § 2144.03.

Applicants respectfully remind Examiner that it is not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. MPEP § 2144.03. For example, assertions of specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. MPEP § 2144.03. *In*

re Ahlert, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

The Examiner states that the limitation is unclear as the claims attempt to compare the amount of filler as a percentage against an amount of solids, without providing a proper standard as to what amount of solids, if any, are present in the claimed invention. As set forth above, applicants respectfully submit that the amount of solids is clear. Applicants have already directed Examiner to portions of the specification detailing the structure and amount of solids. Furthermore, a claim limitation which is considered indefinite cannot be disregarded. MPEP § 2143.03. Applicants respectfully submit that Examiner's "[a]bsent evidence to the contrary . . ." is an attempt to disregard the previously recited claim limitation.

The Examiner additionally states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the amount of filler, motivated by the desire of forming a conventional fibrous web containing a filler suitable for the intended application. The Examiner goes on to state that "Grönroos suggest that the properties of the coated base may be manipulated by the thickness of the coating and that the coating is generally optimizable based on the desired coverage and properties." Nothing in Examiner's citation of Grönroos discloses why it would have been obvious to vary the amount of filler. Furthermore, nothing in Grönroos suggests varying the amount of filler.

Applicants again respectfully remind Examiner that the Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." MPEP § 2142. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Applicants respectfully submit that Examiner's reasoning for why one of ordinary skill in the art would vary the amount of filler lacks rational underpinning to support the legal conclusion of obviousness.

If, however, the examiner still concludes that a *prima facie* case has been made, the burden of coming forward with evidence or arguments shifts to the applicants who may submit additional

evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. MPEP 2142. Applicants respectfully submit that the application as filed includes comparative test data showing that the claimed invention possesses improved properties not expected by the prior art.

The claimed range is unconventional for fillers. Normally it is not technically possible to incorporate the amount of fillers into a fibrous web without almost entirely losing the strength of the web. The surprising properties attainable by the present invention are disclosed and graphically depicted in the specification. Applicants direct the Examiner to paragraphs [0041] – [0044] and Figures 1 - 3 which show the strength of the fibrous web filled with varying concentrations of different materials.

As stated in paragraph [0041], when a granulated filler was added into a sheet of cellulose, based on laboratory tests carried according to the SCAN standards, much higher strength values for tensile strength and bursting strength were obtained than could be anticipated. The test points for various sheets are shown in the figures: the sheet plotted above the 100% line have a greater strength than what could be obtained with pure chemical pulp. As can be seen in the Figures, the present specification gives improved strength and remarkably good results for the claimed range. It is therefore submitted that the claimed invention possesses improved properties not expected by the prior art and presents clear advantages over conventional products.

Applicants respectfully submit that claim 1 and claim 25, directly dependent from independent claim 1, are patentably distinct over Gronroos based at least on the previously cited recitations in independent claim 1 and claim 25. Accordingly, applicants submit that independent claim 1 is in condition for allowance. Such action is respectfully requested.

Claims 2-13 and 25 depend directly from independent claim 1. These dependent claims also add further patentable combinations of features to claim 1. However, since independent claim 1, as amended, is believed to be in condition for allowance, applicants will not address the details of each dependent claim at the present time. Accordingly, applicants submit that claims 1-13 and 25 are now in condition for allowance. Such allowance is respectfully requested.

5. Conclusion

Applicants respectfully requests that a timely Notice of Allowance be issued in this case.

Applicants request that this response be considered a request for a two month extension of time, appropriate for the response to be timely filed. Applicants request that any required fees

needed beyond those submitted with this amendment be charged to the account of Baker & Daniels, Deposit Account No. 02-0390.

The Examiner is invited to contact the undersigned at the telephone number provided below should any question or comment arise during reconsideration of this matter.

If any fees are necessary in connection with this document, please charge Deposit Account No. 02-0390, Baker & Daniels.

Respectfully submitted,

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